

ESTTA Tracking number: **ESTTA276721**

Filing date: **04/08/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | | | |
|---------|--|-------------|---------------|
| Name | Elliot Klein | | |
| Entity | Individual | Citizenship | UNITED STATES |
| Address | 210 East 15 Street 6K New York, NY 10003 UNITED STATES | | |

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| Correspondence information | Elliot Klein 210 East 15 Street 6K New York, NY 10003 UNITED STATES elliot@returnme.com |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 77393771 | Publication date | 03/31/2009 |
| Opposition Filing Date | 04/08/2009 | Opposition Period Ends | 04/30/2009 |
| Applicant | ReturnMoi and design Canada INC. 3551 Boul St-Charles, suite: 369 Kirkland, H9H3C4 CANADA | | |

Goods/Services Affected by Opposition


Class 016. First Use: 2007/02/27 First Use In Commerce: 2007/04/18
All goods and services in the class are opposed, namely: Adhesive labels


Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2947943 | Application Date | 04/14/2004 |
| Registration Date | 05/10/2005 | Foreign Priority Date | NONE |
| Word Mark | RETURNME | | |

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|---------------------|--|
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 035. First use: First Use: 1999/01/02 First Use In Commerce: 2002/01/11 Logistics management in the field of electronically displayed product identification labels |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2382650 | Application Date | 04/01/1999 |
| Registration Date | 09/05/2000 | Foreign Priority Date | NONE |
| Word Mark | RETURNME.COM | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 042. First use: First Use: 1998/12/16 First Use In Commerce: 1999/01/02 lost and found locator services for personal items via a global computer network, namely, assisting others in recovering lost items by providing a subscriber based database registry service and organizing for the contact, pick-up and delivery of the lost item to the subscriber | | |

| | |
|-------------|---|
| Attachments | 78401611#TMSN.jpeg (1 page)(bytes) 75672463#TMSN.gif (1 page)(bytes) Returnmoi_Opposition.pdf (4 pages)(2310135 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

| | |
|-----------|-------------------|
| Signature | /Elliot S. Klein/ |
| Name | Elliot Klein |
| Date | 04/08/2009 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ELLIOT KLEIN

Opposer,

vs.

RETURNMOI AND DESIGN CANADA INC.

Applicant.

§ Opposition No. _____

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§ In the matter of:

§ Application Serial No. 77/393,771

§ Mark: R RETURNMOI

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§ Published in the Official Gazette

§ On March 31, 2009

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NOTICE OF OPPOSITION

Opposer, ELLIOT KLEIN, an individual, having a principal place of business at 210 East 15th Street, Unit 6K, New York, New York 10003 ("Opposer"), believes that he will be damaged by registration of the mark R RETURNMOI (the "Opposed Mark") shown in Application Serial No. 77/393,771, and hereby opposes that application.

As grounds for its opposition, Opposer alleges:

1. Applicant, RETURNMOI AND DESIGN CANADA INC. ("Applicant"), seeks registration of the Opposed Mark for use on "adhesive labels." Applicant filed this application on February 11, 2008, alleging that Applicant first used the Opposed Mark in commerce on April 18, 2007.

2. Opposer, since at least as early as January 1999, before Applicant filed its application to register the Opposed Mark, or began using that mark, has continuously used the mark RETURNME.COM on services for return identification tags and labels.

3. Opposer owns U.S. Trademark Registration No. 2,382,650 for the mark RETURNME.COM for use on "lost and found locator services for personal items via a global computer network, namely, assisting others in recovering lost items by providing a subscriber based database registry service and organizing for the contact, pick-up and delivery of the lost item to the subscriber." The application was filed on April 1, 1999 and the mark was registered on September 5, 2000. Additionally, a Combined Declaration of Use and Incontestability under Sections 8 & 15 was filed on September 7, 2005.

4. Opposer also owns U.S. Trademark Registration No. 2,947,943 for the mark RETURNME for "logistics management in the field of electronically displayed product identification labels." The application was filed on April 22, 2004 and the mark was registered on May 10, 2005.

5. Since its adoption, Opposer has continuously and extensively promoted for sale and/or used its RETURNME.COM and RETURNME mark(s) on its services and the marketing or promotion for related tag and label goods in interstate commerce.

6. Opposer's priority in its "RETURNME.COM" mark precedes Applicant's filing date of February 11, 2008 for Application Serial No. 77/393,771 and first use date of April 18, 2007; Opposer's priority for its "RETURNME" Mark also precedes Applicant's filing date. Therefore, both Opposer's Marks precedes the Applicant's.

7. Since adoption, Opposer has expended considerable sums of money in advertising, promoting, marketing, and otherwise developing its RETURNME.COM and RETURNME mark(s) for return tag and return label identification services for "lost and found locator services."

8. Due to Opposer's distribution, sales, and marketing of its goods and services under its RETURNME.COM and RETURNME mark(s), these mark(s) have acquired extensive goodwill and customer recognition throughout the United States, and the RETURNME.COM AND RETURNME mark(s) have become known throughout the United States as an indicator of goods/services provided by Opposer.

9. The Opposed Mark and Opposer's RETURNME.COM and RETURNME

Mark(s) are confusingly similar in sight, sound, connotation and commercial impression. The Opposed Mark includes the Opposer's "Return" and "Me" standard characters with the words "Return" and "Moi" in its literal mark element. Specifically, the word "Return" appears as an identical literal match. The adjacent word, "Moi" translates from the French language and means "ME" in the English language. Applicant is a Canadian company located in the Province of Quebec, Canada and its application shows it is applying for a U.S. Mark initially based on a digital photo specimen of an internet-based lost and found service with an adhesive label on a product from a foreign application for same goods/services already in process in Canada (Canadian Trademark Application No. 1343777). French is the sole official language in the province of Quebec. By using the wording "Return" and "Moi" as part of its literal mark, Applicant misleads consumers to believe it is the source of Opposer's United States of America's RETURNME.COM and/or RETURNME goods/services.

10. The Applicant's mark is a literal element logo with the name "RETURNMOI," and the proposed mark consists of the color green that appears in the wording 'RETURN' and in the triangular design elements. The color blue appears in the letter 'R' as part of the literal element logo and in the wording 'MOI' and in the triangular design elements, that includes the words "Return" and "me" by reference that the word "moi" that translates into English as "me" and therefore includes the Opposer's mark(s) that include the word(s) "return" and "me."

11. The Opposer's Marks in its registrations 2,382,650 and 2,947,943 are RETURNME.COM and RETURNME. According to the well-established doctrine of foreign equivalents, an applicant may not register foreign words or terms if the English language equivalent has been previously registered for related products or services. In re Perez, 21 USPQ2d 1075 (TTAB 1991); In re American Safety Razor Co., 2 USPQ2d 1459 (TTAB 1987); In re Ithaca Industries, Inc., 230 USPQ 702 (TTAB 1986); In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). TMEP §1207.01(b)(vi). The applicant's mark English wording translation and impression is the foreign equivalent of the registrant's mark and its use on related products will lead to consumer confusion.

12. The Opposed Mark and Opposer's Mark(s) are or will be used with the same or related goods and/or services. Therefore, Applicant's mark is likely to cause

confusion, or to cause mistake, or to deceive, all within the meaning of 15 U.S.C. § 1052(a) and §1052(d).

13. On information and belief, the goods to which Applicant's alleged "R RETURN MOI" mark will be advertised, or otherwise applied to goods/services upon which Opposer's "RETURNME and "RETURNME" Mark(s) are used and registered and are likely to be related to Opposer's goods. Consequently, Applicant's use of the Opposed Mark in connection with adhesive labels the Applicant's submitted specimen(s) show that they "serve in assisting others in recovering lost items," or serve for "identification labels" and are likely to cause consumers to be confused, deceived or misled into the mistaken belief that Applicant's goods emanate from, are affiliated with, or are otherwise related to Opposer, when in fact they are not. For the foregoing reasons, the Opposed Mark is likely to cause confusion, or to cause mistake, or to deceive.

14. If the Opposed Mark becomes registered, it will negate Opposer's exclusive right to use its registered RETURNME.COM and RETURNME mark(s) and thus weaken Opposer's trademark rights. Therefore, Opposer will be damaged and harmed by the use and registration of the Opposed Mark.

WHEREFORE, Opposer prays that Application Serial No. 77/393,771 be refused, that no registration be issued to Applicant, and that this opposition be sustained in favor of Opposer.

This Notice of Opposition is being submitted through the Electronic System for Trademark Trials and Appeals (ESTTA). The requisite \$300.00 fee and any additional fees have been included with the submission.

Respectfully submitted,

By: 

Elliot Klein, Individual

210 East 15th St., Unit 6K,
New York, NY 10003